



APL/S
JFW

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0987-00

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Daniela GIACCHETTI et al.

Application No.: 10/024,621

Filed: December 21, 2001

For: SYSTEMS AND METHODS FOR
PROVIDING BEAUTY GUIDANCE

) Group Art Unit: 3629
) Examiner: Igor N. BORISSOV
) Confirmation No.: 3961
)
)

Mail Stop Appeal Brief--Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the

Notice of Appeal filed on May 31, 2005.

This application is on behalf of a

Small Entity Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

\$250.00 (Small Entity)

\$500.00 (Large Entity)

TOTAL FEE DUE:

Appeal Brief Fee \$500.00

Extension Fee (if any) \$0.00

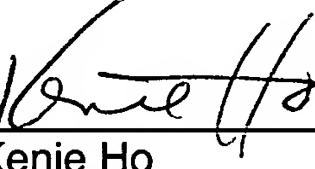
Total Fee Due \$500.00

Enclosed is a check for \$500.00 to cover the above fee.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested. The Commissioner is authorized to charge necessary fees to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 1, 2005

By: 
Kenie Ho
Reg. No. 51,808



**RESPONSE UNDER 37 C.F.R. § 41.37
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 3629**

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0987-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Daniela GIACCHETTI et al.) Group Art Unit: 3629
Application No.: 10/024,621) Examiner: Igor N. BORISSOV
Filed: December 21, 2001) Confirmation No.: 3961
For: SYSTEMS AND METHODS FOR)
PROVIDING BEAUTY GUIDANCE)
)

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed May 31, 2005 and further to Board Rule 41.37, Appellants present this brief and enclose herewith a check for the fee of \$500.00 required under 37 C.F.R. § 1.17(c).

This Appeal responds to the December 1, 2004, final rejection of claims 1-69.

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

TABLE OF CONTENTS

I.	Real Party In Interest	6
II.	Related Appeals and Interferences	7
III.	Status Of Claims	8
IV.	Status Of Amendments	9
V.	Summary Of Claimed Subject Matter	10
	A. Independent Claim 1	10
	B. Independent Claim 36	10
	C. Independent Claim 53	11
	D. Independent Claim 55	11
	E. Independent Claim 56	12
	F. Independent Claim 59	13
	G. Independent Claim 67	13
VI.	Grounds of Rejection.....	15
VII.	Argument	16
	A. The Rejection Under 35 U.S.C. § 112, ¶ 1 Should Be Reversed	16
	1. Claims 1-69	16
	a. The initial burden of establishing a reasonable basis to question the enablement of the claimed invention has not been met.....	16
	b. The specification contains sufficient information to enable one reasonably skilled in the pertinent art to make and use the claimed invention.	18
	B. The Rejection Under 35 U.S.C. § 101 For Not Reciting A Limitation In The Technological Arts Should Be Reversed.....	19
	1. Claims 1-10, 12, 13, 15-27, 30, 31, 33-55, and 67-69	19

a.	The claims are indeed within the useful or technological arts, regardless of whether they specifically recite means to carry out a process or computer-related limitations, and the Office Action provides no authority whatsoever sustaining a requirement that a statutory method claim must include limitations reciting means to carry out the method.....	19
b.	"[P]roviding guidance . . . at least including beauty advice and being a function of at least some of . . . profile information and . . . [a] birth related classification," as recited in claim 1, is a useful, non-abstract result that could facilitate, for example, implementing a marketing initiative.....	21
c.	The specification discusses several technological applications related to the inventions defined in the claims, and thereby shows "a practical application in the technological arts."	22
2.	Claim 11	23
a.	Claim 11 expressly recites a "network," a "server side," and a "client side," which clearly involves technology.....	23
3.	Claim 14	24
a.	Claim 14 expressly recites a "network," which clearly involves technology.	24
4.	Claim 28	24
a.	Claim 28 expressly recites a "mobile receiver/transmitter," which clearly involves technology.....	24
5.	Claims 29 and 32.....	24
a.	Claims 29 and 32 expressly recite a "website," which clearly involves technology.	24
C.	The Rejection Under 35 U.S.C. § 101 For Lack Of Utility Should Be Reversed.....	25
1.	Claims 1-55 and 67-69	25
a.	The claimed invention may be used to market beauty products and provide beauty advice guidance to a subject.	25
D.	The Rejection Under 35 U.S.C. § 102(e) Over <i>Maloney</i> Should Be Reversed.....	26

1.	<i>Disclosure of Maloney</i>	26
2.	Claims 1, 4-6, 9-15, 17-20, 24-27, 29-36, 43-47, 51-53, 56, 60-62, and 64-67	27
a.	<i>Maloney does not teach or suggest “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification,” as recited in claim 1.....</i>	27
3.	Claims 53 and 56.....	29
a.	<i>Maloney does not teach or suggest “recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information,” as recited in claim 53.</i>	29
E.	The Rejection Under 35 U.S.C. § 103(a) Over <i>Maloney</i> In View Of <i>Shim</i> Should Be Reversed	30
1.	<i>Disclosure of Shim</i>	30
2.	Claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69	30
a.	<i>Each of claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69 depends upon one of base claims 1, 36, 59, and 67. Shim fails to cure Maloney’s deficiencies.....</i>	30
3.	Claims 54, 57, and 58.....	33
a.	<i>Maloney and Shim do not teach or suggest, separately or in combination, “recommending at least one beauty product to [a] subject as a function of a birth-related classification and at least some of the received profile information” or “providing to a user of [a] second website a recommendation to use a beauty product offered for sale through [a] first website, the recommendation being a function of a birth-related classification of the user.”.....</i>	33
4.	Claim 55	34
a.	<i>Neither Shim nor Maloney teaches or suggests, separately or in combination, “providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject’s astrological horoscope sign and at least some of the received profile information.”</i>	34

F. The Rejection Under 35 U.S.C. § 103(a) Over <i>Maloney</i> In View Of <i>Shim</i>, <i>Nordbye</i>, and <i>Williams</i> Should Be Reversed	35
1. Disclosure of <i>Nordbye</i>	35
2. Disclosure of <i>Williams</i>	35
3. Claims 21-23 and 48-50	35
a. <i>Maloney</i> , <i>Shim</i> , <i>Nordbye</i> , and <i>Williams</i> do not teach or suggest, separately or in combination, “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification” or “dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified.”	35
VIII. Conclusion.....	38
IX. Claims Appendix.....	39
X. Evidence Appendix	51
XI. Related Proceedings Appendix	52

I. REAL PARTY IN INTEREST

The real party in interest is L'OREAL SA, the assignee of the entire right, title, and interest in the application.

II. RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or assignee are aware, that may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-69 have been finally rejected and are subject to this appeal.

IV. STATUS OF AMENDMENTS

No Amendments have been filed since the final Office Action of December 1, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

The subject matter set forth in independent claim 1 relates to a method of providing guidance for a subject. The method comprises receiving profile information about the subject, the profile information reflecting at least one of physical attribute information and lifestyle information (e.g., Fig. 1, 120; Fig. 2, 200; Fig. 5, 515; Fig. 6, 515; p. 9, l. 16 to p. 12, l. 15; p. 25, ll. 6-10; p. 29, l. 10 to p. 30, l. 7; p. 31, l. 11 to p. 34, l. 8; p. 44, l. 12 to p. 45, l. 5; p. 49, l. 10 to p. 50, l. 19);¹ receiving information reflecting a classification relating to birth of the subject (e.g., Fig. 1, 130; Fig. 3, 300; Fig. 4, 400; Fig. 5, 515; Fig. 6, 515; p. 13, l. 1 to p. 15, l. 5; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 7; p. 34, ll. 9-15; p. 44, l. 12 to p. 45, l. 5); and providing guidance for the subject, the guidance including at least beauty advice and being a function of at least some of the profile information and the birth-related classification (e.g., Fig. 1, 140; Fig. 5, 515; Fig. 6, 515; Fig. 10, 1005; Fig. 11, 1140; Fig. 12, 1240; p. 15, l. 6 to p. 25, l. 3; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 19; p. 34, l. 16 to p. 35, l. 21; p. 43, l. 22 to p. 44, l. 12; p. 46, l. 20 to p. 47, l. 7).

B. Independent Claim 36

The subject matter set forth in independent claim 36 relates to a method of providing guidance to a subject. The method comprises establishing a set of criteria for classifying the subject in at least one of a plurality of predefined categories, the criteria including at least one of personal attribute information and lifestyle information (e.g.,

¹ In referring to the specification, Appellants do not intend to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Appellants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Fig. 11, 1120; p. 18, l. 3 to p. 19, l. 16); advising the subject of the at least one predefined categories into which the subject is classified (e.g., Fig. 11, 1130; p. 19, ll. 17-20); and dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified (e.g., Fig. 11, 1140; p. 19, l. 21 to p. 23, l. 14).

C. Independent Claim 53

The subject matter set forth in independent claim 53 relates to a method of marketing beauty products. The method comprises receiving profile information about a subject, the profile information reflecting at least one of physical attribute information and lifestyle information about the subject (e.g., Fig. 1, 120; Fig. 2, 200; Fig. 5, 515; Fig. 6, 515; p. 9, l. 16 to p. 12, l. 15; p. 25, ll. 6-10; p. 29, l. 10 to p. 30, l. 7; p. 31, l. 11 to p. 34, l. 8; p. 44, l. 12 to p. 45, l. 5; p. 49, l. 10 to p. 50, l. 19); identifying a birth-related classification of the subject (e.g., Fig. 1, 130; Fig. 3, 300; Fig. 4, 400; Fig. 5, 515; Fig. 6, 515; p. 13, l. 1 to p. 15, l. 5; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 7; p. 34, ll. 9-15); and recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information (e.g., Fig. 1, 140; Fig. 5, 515; Fig. 6, 515; Fig. 10, 1005; Fig. 11, 1140; Fig. 12, 1240; p. 15, l. 6 to p. 25, l. 3; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 19; p. 34, l. 16 to p. 35, l. 21; p. 45, l. 19 to p. 47, l. 7).

D. Independent Claim 55

The subject matter set forth in independent claim 55 relates to a method of marketing beauty products. The method comprises receiving profile information about a subject, the profile information reflecting at least one of physical attribute information

and lifestyle information about the subject (e.g., Fig. 1, 120; Fig. 2, 200; Fig. 5, 515; Fig. 6, 515; p. 9, l. 16 to p. 12, l. 15; p. 25, ll. 6-10; p. 29, l. 10 to p. 30, l. 7; p. 31, l. 11 to p. 34, l. 8; p. 44, l. 12 to p. 45, l. 5; p. 49, l. 10 to p. 50, l. 19); receiving information reflective of an astrological horoscope sign of the subject (e.g., Fig. 1, 130; Fig. 3, 300; Fig. 4, 400; Fig. 5, 515; Fig. 6, 515; p. 13, l. 1 to p. 15, l. 5; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 7; p. 34, ll. 9-15; p. 44, l. 12 to p. 45, l. 5); and providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject's astrological horoscope sign and at least some of the received profile information (e.g., Fig. 1, 140; Fig. 5, 515; Fig. 6, 515; Fig. 10, 1005; Fig. 11, 1140; Fig. 12, 1240; p. 15, l. 6 to p. 25, l. 3; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 19; p. 34, l. 16 to p. 35, l. 21; p. 43, l. 22 to p. 44, l. 12; p. 45, l. 19 to p. 47, l. 7).

E. Independent Claim 56

The subject matter set forth in independent claim 56 relates to a method of marketing beauty products. The method comprises maintaining a first website offering for sale beauty products (e.g., Fig. 12, 1220; p. 24, ll. 5-8); establishing a relationship between the first website and a second website dispensing birth-related classification information (e.g., Fig. 12, 1230; p. 24, ll. 9-12); providing to a user of the second website a recommendation to use a beauty product offered for sale through the first website, the recommendation being a function of a birth-related classification of the user (e.g., Fig. 12, 1240; p. 24, ll. 13-17); and providing on the second website a link to the first website, and informing the user of the second website of the ability to purchase the beauty product through the link to the first website (e.g., Fig. 12, 1250; p. 24, ll. 18-21).

F. Independent Claim 59

The subject matter set forth in independent claim 59 relates to a system of providing guidance for a subject. The system comprises a component for receiving profile information about the subject, the profile information reflecting at least one of physical attribute information and lifestyle information (e.g., Fig. 1, 120; Fig. 2, 200; Fig. 5, 515; Fig. 6, 515; p. 9, l. 16 to p. 12, l. 15; p. 25, ll. 6-10; p. 29, l. 10 to p. 30, l. 7; p. 31, l. 11 to p. 34, l. 8; p. 44, l. 12 to p. 45, l. 5; p. 49, l. 10 to p. 50, l. 19); a component for receiving information reflecting a birth-related classification of the subject (e.g., Fig. 1, 130; Fig. 3, 300; Fig. 4, 400; Fig. 5, 515; Fig. 6, 515; p. 13, l. 1 to p. 15, l. 5; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 7; p. 34, ll. 9-15; p. 44, l. 12 to p. 45, l. 5); and a component for providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the subject's birth-related classification (e.g., Fig. 1, 140; Fig. 5, 515; Fig. 6, 515; Fig. 10, 1005; Fig. 11, 1140; Fig. 12, 1240; p. 15, l. 6 to p. 25, l. 3; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 19; p. 34, l. 16 to p. 35, l. 21; p. 43, l. 22 to p. 44, l. 12; p. 46, l. 20 to p. 47, l. 7).

G. Independent Claim 67

The subject matter set forth in independent claim 67 relates to a method of providing guidance for a subject. The method comprises receiving profile information about the subject, the profile information reflecting at least one of physical attribute information and lifestyle information (e.g., Fig. 1, 120; Fig. 2, 200; Fig. 5, 515; Fig. 6, 515; p. 9, l. 16 to p. 12, l. 15; p. 25, ll. 6-10; p. 29, l. 10 to p. 30, l. 7; p. 31, l. 11 to p. 34, l. 8; p. 44, l. 12 to p. 45, l. 5; p. 49, l. 10 to p. 50, l. 19); receiving information reflecting at least one of when and where the subject was born (e.g., Fig. 1, 130; Fig. 3, 300; Fig. 4,

400; Fig. 5, 515; Fig. 6, 515; p. 13, l. 1 to p. 15, l. 5; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 7; p. 34, ll. 9-15; p. 44, l. 12 to p. 45, l. 5); and providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and a classification correlating to at least one of when and where the subject was born (e.g., Fig. 1, 140; Fig. 5, 515; Fig. 6, 515; Fig. 10, 1005; Fig. 11, 1140; Fig. 12, 1240; p. 15, l. 6 to p. 25, l. 3; p. 25, ll. 6-10; p. 29, l. 15 to p. 30, l. 19; p. 34, l. 16 to p. 35, l. 21; p. 43, l. 22 to p. 44, l. 12; p. 46, l. 20 to p. 47, l. 7).

VI. GROUNDS OF REJECTION

- A. Claims 1-69 stand rejected under 35 U.S.C. § 112, ¶ 1 as based on an allegedly non-enabling disclosure.
- B. Claims 1-55 and 67-69 stand rejected under 35 U.S.C. § 101 for allegedly not reciting a limitation in the technological arts.
- C. Claims 1-55 and 67-69 stand rejected under 35 U.S.C. § 101 for allegedly lacking utility.
- D. Claims 1, 4-6, 9-15, 17-20, 24-27, 29-36, 43-47, 51-53, 56, 60-62, and 64-67 stand rejected under 35 U.S.C. § 102(e) based on PCT International Publication No. WO 01/18674 ("Maloney").
- E. Claims 2, 3, 7, 8, 16, 28, 37-42, 54, 55, 57, 58, 63, 68, and 69 stand rejected under 35 U.S.C. § 103(a) based on *Maloney* in view of U.S. Patent Application Publication No. 2003/0078854 ("Shim").
- F. Claims 21-23 and 48-50 stand rejected under 35 U.S.C. § 103(a) based on *Maloney* in view of *Shim*, U.S. Patent No. 3,936,957 ("Nordbye"), and U.S. Patent No. 3,968,661 ("Williams").

VII. ARGUMENT

A. The Rejection Under 35 U.S.C. § 112, ¶ 1 Should Be Reversed

1. Claims 1-69

a. **The initial burden of establishing a reasonable basis to question the enablement of the claimed invention has not been met.**

The initial burden in rejecting claims 1-69 under 35 U.S.C. § 112, ¶ 1 has not been met. As the M.P.E.P. makes clear, “[i]n order to make [the] rejection, . . . [there is an] initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” M.P.E.P. § 2164.04 (8th Ed., May 2004) (internal citations omitted). Any conclusion regarding non-enablement should be based on specific findings of fact that are supported by evidence. See *id.* “The minimal requirement is . . . to give reasons for the uncertainty of the enablement.” *Id.* And when doubt arises as to enablement because of missing information about essential parts or relationships between parts, “the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.” *Id.* In particular, references should be supplied if possible and specific technical reasons are required. *Id.*

In this case, the Office Action of December 1, 2004 states that “the connection between [an] *astrological horoscope sign* and a *beauty product* is not clear.” Office Action of December 1, 2004 (“OA”) at 2. It further states that:

The functionality connecting the method steps of . . . “receiving astrological horoscope sign of a consumer” and “recommending to the consumer a beauty product” is critical or essential to the practice of the invention, but not included in the claim(s) [and] not enabled by the disclosure. *Id.*

The Office Action, however, fails to provide specific findings or cite any evidence to support the above allegations. For example, the Office Action provides no evidence to support the allegation that “the connection between [an] astrological horoscope sign and a beauty product is not clear.” *Id.* Further, the Office Action cites no evidence concerning the allegation that the “[t]he functionality connecting the method steps of ... receiving astrological horoscope sign of a consumer and recommending to the consumer a beauty product is critical or essential.” *Id.* Specifically, the Office Action provides no technical reasons why certain subject matter not included in the claims is “critical or essential” and does not indicate what “functionality” is specifically deemed essential and missing from the claims. Furthermore, the Office Action does not demonstrate why a skilled artisan, considering the specification, could not make and use the claimed invention nor why a skilled artisan could not supply any missing information without undue experimentation. The Office Action provides absolutely no explanation to support the allegations relating to enablement.

For at least the above reasons, the initial burden establishing a reasonable basis to question the enablement of the claimed invention has not been met. Specifically, the Office Action has not provided adequate reasons or evidence to support, *prima facie*, that a skilled artisan could not make and use the invention without undue experimentation, given the knowledge of skill in the art combined with the teachings and examples provided in the specification.

b. The specification contains sufficient information to enable one reasonably skilled in the pertinent art to make and use the claimed invention.

Notwithstanding the Office Action's failure to meet the initial burden of proving non-enablement, the specification contains sufficient information to enable one reasonably skilled in the pertinent art to make and use the claimed invention. For instance, the specification provides examples (see e.g., pp. 13-18 and 23-24) explaining how beauty guidance is provided using profile information and a subject's birth-related classification, such as astrological information. Further, the specification describes an exemplary operating environment in which the claimed invention can be implemented (see e.g., Fig. 5 and accompanying description). And, contrary to the Examiner's allegation, the specification clearly discloses how astrological signs and beauty products can be related within the context of the claims. The specification also makes clear how astrological signs or other birth-related information can be used to provide beauty product recommendations (see e.g., pp 15- 16). Hence, a skilled artisan, considering the teachings of the specification, could in fact make and use the claimed invention.

Additionally, Appellants call attention to M.P.E.P. § 2164.08(c), which states:

In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical.

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly

critical feature, tends to rebut the argument of criticality.
M.P.E.P. § 2164.08(c) (internal citations omitted).

The “functionality connecting” the features of “receiving information reflecting a classification relating to birth of the subject” and “providing guidance for the subject” is not omitted, but is expressed within the language of claim 1. As M.P.E.P. § 2164.08(c) indicates, Appellants are not required to limit the claims to preferred features in the absence of limiting prior art.

B. The Rejection Under 35 U.S.C. § 101 For Not Reciting A Limitation In The Technological Arts Should Be Reversed

1. Claims 1-10, 12, 13, 15-27, 30, 31, 33-55, and 67-69

The Office Action states claims 1-10, 12, 13, 15-27, 30, 31, 33-55, and 67-69 are not within the technological arts because they are (1) completely silent with regard to technology, (2) directed to abstract ideas, and (3) not in compliance with M.P.E.P. § 1206 (IV)(B)(2)(b) "Statutory Process Claims." OA at 8 and 9. Each of these three points is addressed below.

a. The claims are indeed within the useful or technological arts, regardless of whether they specifically recite means to carry out a process or computer-related limitations, and the Office Action provides no authority whatsoever sustaining a requirement that a statutory method claim must include limitations reciting means to carry out the method.

Regarding the first point, the Office Action states that the claims are silent regarding technology because they recite “no limitations . . . that would suggest a computer or data processing device.” OA at 8. In an attempt to support this misunderstanding of the requirements for 35 U.S.C. § 101, the Office Action cites *In re Musgrave*, 167 U.S.P.Q. 280 (CCPA 1970). OA at 3. That case, however, expressly asserts that the presumption that the law “requires all steps of a statutory ‘process’ to be

physical acts applied to physical things" is an "erroneous idea." *In re Musgrave*, 167 U.S.P.Q. at 289. The court noted that "it was a misconstruction to assume that 'all processes, to be patentable, must operate physically upon substances.'" *Id.* at 289. Additionally, the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations "reflects a misunderstanding of...[the] case law." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999). Furthermore, in *Ex parte Bowman*, 61 U.S.P.Q.2d 1669 (2001), also cited in the Office Action, the Board's decision to affirm the § 101 rejection was based in part on the fact that neither the claims nor the specification discussed "the use of any technology with respect to the claimed invention." *Ex parte Bowman*, 61 U.S.P.Q.D.2d at 1671 (emphasis and underline added). Because of this, the Board found that the invention was "not tied to any technological art . . . and [was] not a useful art." *Id.*

The specification in this application discusses several technological applications related to the claimed invention (see e.g., Figs. 2-10 and accompany description). Accordingly, the Office Action's statement that the claims are not within the technological arts because they do not recite means to carry out a process does not comport with the requirements of 35 U.S.C. § 101. The claims are indeed within the useful or technological arts, regardless of whether they specifically recite means to carry out a process or computer-related limitations, and the Office Action provides no authority whatsoever sustaining a requirement that a statutory method claim must include limitations reciting means to carry out the method.

b. “[P]roviding guidance . . . at least including beauty advice and being a function of at least some of . . . profile information and . . . [a] birth related classification,” as recited in claim 1, is a useful, non-abstract result that could facilitate, for example, implementing a marketing initiative.

Regarding the second point, the Office Action states that the claims are directed to abstract ideas because they “are no more than a suggested idea of providing . . . beauty advice to a customer based on information about the customer.” OA at 8. To support this, the Office Action cites *In re Toma*, 197 U.S.P.Q. 852 (CCPA 1978). OA at 4. That case, however, makes clear that the language in the case law regarding mental steps and technological arts “was not intended to form a basis for a new § 101 rejection” *In re Toma*, 197 U.S.P.Q. at 857. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 1375 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). And, if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101. See *id.*

The conclusory statement that the claims are directed to “purely an abstract idea” is unsupported in the Office Action and does not establish that the claims are in fact directed to an abstract idea. OA at 8. The claims do in fact include recitations that produce “concrete, tangible and useful” results and, therefore, accomplish a practical application and are not abstract. *State Street*, 149 F.3d at 1375. For example, “providing guidance . . . at least including beauty advice and being a function of at least some of . . . profile information and . . . [a] birth related classification,” as recited in claim

1, is a useful, non-abstract result that could facilitate, for example, implementing a marketing initiative.

c. The specification discusses several technological applications related to the inventions defined in the claims, and thereby shows “a practical application in the technological arts.”

Regarding the third point, the Office Action states that the claims do not comply with M.P.E.P. § 2106 (IV)(B)(2)(b) because the claims “do not recite any physical transformation of data whatsoever.” OA at 8 and 9. M.P.E.P. § 2106(IV)(B)(2)(b) specifies, however, that a claimed process is statutory if it is “limited to a practical application within the technological arts.” Also, M.P.E.P. § 2106(IV)(B)(2)(b)(ii) states that:

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful.”

M.P.E.P. § 2106(IV)(B)(2)(b)(ii) (internal citations omitted).

Hence, regardless of whether the claims recite a process that results in a physical transformation outside a computer, the claims are limited to a practical application within the technological arts because the claims produce concrete, tangible and useful results.

Additionally, M.P.E.P. § 2106(II)(A) states that:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101 . . . [w]hen such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Id., § 2106(II)(A) (internal citations omitted).

In this case, the Examiner fails to establish a *prima facie* case required by M.P.E.P. § 2106. The Examiner makes conclusory statements unsupported by any evidence establishing that the claims are “devoid of any limitation to a practical application in the technological arts,” as alleged by the Examiner.

Within the context of 35 U.S.C. § 101, one should consider the accompanying disclosure when construing a claim’s practical application. See M.P.E.P. §§ 2106(II)(A). Appellants are entitled to point out portions of the specification to show practical application of claims, and such portions of the specification should be considered. See *id.* In this case, the specification (see e.g., Figs. 3-10 and accompany description) discusses several technological applications related to the inventions defined in the claims, thereby showing “a practical application in the technological arts.”

Hence, for at least the above reasons, the rejection of claims 1-10, 12, 13, 15-27, 30, 31, 33-55, and 67-69 under 35 U.S.C. § 101 for not reciting a limitation in the technological arts should be reversed.

2. Claim 11

a. **Claim 11 expressly recites a “network,” a “server side,” and a “client side,” which clearly involves technology.**

Claim 11 expressly recites a “network,” a “server side,” and a “client side,” which clearly involves technology. Hence, the invention of claim 11 is within the technological arts. For at least this reason, the rejection of claim 11 under 35 U.S.C. § 101 should be reversed. Further, because claim 11 depends upon claim 1, the rejection should also be reversed for the reasons discussed above for the Section 101 rejection of claim 1.

3. Claim 14

a. Claim 14 expressly recites a “network,” which clearly involves technology.

Claim 14 expressly recites a “network,” which clearly involves technology.

Hence, claim 14 is within the technological arts. For at least this reason, the rejection of claim 14 under 35 U.S.C. § 101 should be reversed. Further, because claim 14 depends upon claim 1, the rejection should also be reversed for the reasons discussed above for the Section 101 rejection of claim 1.

4. Claim 28

a. Claim 28 expressly recites a “mobile receiver/transmitter,” which clearly involves technology.

Claim 28 expressly recites a “mobile receiver/transmitter,” which clearly involves technology. Hence, claim 28 is within the technological arts. For at least this reason, the rejection of claim 28 under 35 U.S.C. § 101 should be reversed. Further, because claim 28 depends upon claim 1, the rejection should also be reversed for the reasons discussed above for the Section 101 rejection of claim 1.

5. Claims 29 and 32

a. Claims 29 and 32 expressly recite a “website,” which clearly involves technology.

Claims 29 and 32 expressly recite a “website,” which clearly involves technology. Hence, claims 29 and 32 are within the technological arts. For at least this reason, the rejection of claims 29 and 32 under 35 U.S.C. § 101 should be reversed. Further, because claims 29 and 32 depend upon claim 1, the rejection should also be reversed for the reasons discussed above for the Section 101 rejection of claim 1.

C. The Rejection Under 35 U.S.C. § 101 For Lack Of Utility Should Be Reversed

1. Claims 1-55 and 67-69

a. The claimed invention may be used to market beauty products and provide beauty advice guidance to a subject.

According to the M.P.E.P., an asserted utility “is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion.” M.P.E.P. § 2107.02(III)(B). A conclusion that an asserted utility is not credible can be reached only after the Office has evaluated both the assertion of the application regarding utility and any evidentiary basis of that assertion. *Id.* “Incredible utility’ is a conclusion, not a starting point for analysis under 35 U.S.C. § 101.” *Id.* (underline in original).

The Office Action states the claimed invention lacks utility because it “is directed to [an] invention . . . [that] is not credible.” OA at 9. In particular,

[t]he examiner stipulates that it is more likely than not that one of ordinary skill in the art would doubt the credibility of beauty advice based on an astrological horoscope sign of [a] subject. The specification does not provide any indication of *how knowledge of the zodiac sign of the subject can lead to generating [a] recommendation [on] what type of cosmetic to use*. Furthermore, the specification does not provide any indication of how one of ordinary skill in the art would believe that a *course of future events may change based on use of certain beauty products*. *Id.* (emphasis in original).

Firstly, the Examiner has provided no evidence demonstrating that one of ordinary skill in the art would doubt the credibility of beauty advice based on an astrological horoscope sign of a subject. The Examiner merely makes a conclusory remark that one of ordinary skill in the art would do so. Secondly, contrary to the Examiner’s allegation, the specification does indicate how a zodiac sign of the subject

can be used to generate a recommendation on the type of cosmetic to use (see e.g., pp. 15 and 16). Thirdly, it is irrelevant whether or not the specification indicates how one of ordinary skill in the art would believe that a course of future events may change based on use of certain beauty products because that is not pertinent to demonstrating utility under 35 U.S.C. § 101.

In this case, Appellants provide several exemplary uses for the claimed invention. Page 7 of the specification indicates that such uses may include (but are not limited to) providing beauty advice guidance to a subject and marketing beauty products to the subject. Further, page 6 of the specification states:

Cosmetics are a multibillion dollar business carried out in nearly every country of the world. Astrology is used by many for entertainment purposes, while others maintain that the symbolism of astrology can provide a deeper understanding of ourselves and of events. For whatever purpose, both astrology and cosmetics enjoy widespread use.

Accordingly, the claimed invention may be used to market beauty products and provide beauty advice guidance to a subject and these are credible uses.

D. The Rejection Under 35 U.S.C. § 102(e) Over *Maloney* Should Be Reversed

1. Disclosure of *Maloney*

Maloney describes collecting “consumer profiling data (30),” which includes “psychological, physiological and attitudinal information about the consumer.” *Maloney* at 6 and 9. *Maloney* mentions that psychological and attitudinal information include “personality information, visual preferences, [and] expectation information.” *Id.* at 9. Specifically, *Maloney* mentions collecting “preferred colors and styles, lifestyle, life stage, attitude, desired look of hair, desired look of face and level of involvement.” *Id.* at

7. With *Maloney's* system, a user "is provided with a list of one or more products (40) . . . that correspond to the consumer profiling category." *Id.* at 7 and 9.

2. Claims 1, 4-6, 9-15, 17-20, 24-27, 29-36, 43-47, 51-53, 56, 60-62, and 64-67

a. *Maloney does not teach or suggest "providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification," as recited in claim 1.*

In order for a claim to be anticipated by a prior art reference under 35 U.S.C. § 102, each and every element in the claim must be found, either expressly or inherently, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Cal., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Further, the identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1929 (Fed. Cir. 1989).

See also M.P.E.P. § 2131.

Maloney fails to teach or suggest each and every element of the claimed invention. Although *Maloney* mentions providing a list of products to a consumer based on a consumer profile category, the reference does not teach or suggest "providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification," as recited in claim 1. Even if *Maloney's* customized list of products were consistent with the claimed "beauty advice," *Maloney* does not teach or suggest that the list of products is "a function of at least some of the profile information and [a] . . . birth-related classification," as claimed. Collecting physiological, psychological, and attitudinal information, as mentioned by *Maloney*, does not teach or suggest a "birth-related

classification," as recited in claim 1. Hence, for at least the foregoing reasons, *Maloney* fails to teach or suggest the "providing guidance" feature of claim 1.

Because *Maloney* does not teach each and every feature of claim 1, as a matter of law, it cannot anticipate this claim. As such, the rejection of claim 1 under 35 U.S.C. §102(e) based on *Maloney* should be reversed.

Each of claims 36, 59, and 67, although of different scope, recites subject matter similar to the "providing guidance" feature of claim 1. In particular, claim 36 recites, *inter alia*:

dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified;

claim 59 recites, *inter alia*:

a component for providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the subject's birth-related classification;

and claim 67 recites, *inter alia*:

providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and a classification correlating to at least one of when and where the subject was born.

Maloney does not anticipate independent claims 36, 59, and 67 for at least reasons similar to those presented above in connection with claim 1.

Each of claims 4-6, 9-15, 17-20, 24-27, 29-35, 43-47, 51, 52, 60-62, and 64-66 depends upon independent claim 1, 36, or 59. *Maloney* fails to anticipate claims 4-6, 9-15, 17-20, 24-27, 29-35, 43-47, 51, 52, 60-62, and 64-66 for at least the same reasons

as those discussed above in connection with claims 1, 36, and 59, from which they depend.

3. Claims 53 and 56

a. ***Maloney does not teach or suggest “recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information,” as recited in claim 53.***

Independent claim 53 recites, *inter alia*:

recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information.

Similar to claim 53, independent claim 56 recites, *inter alia*:

providing to a user of the second website a recommendation to use a beauty product offered for sale through the first website, the recommendation being a function of a birth-related classification of the user.

*Maloney does not teach or suggest at least the above features. The Examiner rejected independent claims 53 and 56 for the same reasons presented for claim 1. OA at 10. Despite the Examiner’s allegations, however, providing a list of products based on “psychological, physiological and attitudinal information about the consumer,” as described by *Maloney*, is not consistent with recommending at least one beauty product as “a function of a birth-related classification,” as recited in claims 53 and 56. Because *Maloney* does not teach or suggest each and every feature of claims 53 and 56, it cannot anticipate these claims, as a matter of law.*

E. The Rejection Under 35 U.S.C. § 103(a) Over *Maloney* In View Of *Shim* Should Be Reversed

1. Disclosure of *Shim*

Shim is directed to Internet advertising. *Shim*, abstract. Advertisements are displayed to users “according to character type.” *Id.*, ¶ 0201. *Shim* mentions collecting information about “zodiac” signs and “when the user is born.” *Id.*, ¶¶ 0175 and 0180. The user’s “character type” can be analyzed according to this collected information using “fortune studies.” *Id.*, ¶ 0181. *Shim* also describes “creating user groups according to type, and classifying . . . goods suited to the corresponding user groups . . .” *Id.*, ¶ 0169. User information classified according type can be used for target marketing. *Id.*, ¶ 187. Advertisements can be provided from “health and beauty clinics” and information about a “beauty salon” can be displayed. *Shim*, ¶¶ 0052 and 0207.

2. Claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69

a. Each of claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69 depends upon one of base claims 1, 36, 59, and 67. *Shim* fails to cure *Maloney*’s deficiencies.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” *Id.*

Each of claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69 depends upon one of base claims 1, 36, 59, and 67. For at least reasons similar to those presented above in connection with claims 1, 36, 59, and 67, claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69 are not anticipated or rendered obvious by *Maloney*.

Further, *Shim* fails to cure *Maloney's* deficiencies. *Shim* does not teach or suggest “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification,” as recited in claim 1, and does not teach or suggest the related “guidance” features of claims 36, 59, and 67. Targeting advertisements from beauty clinics, as mentioned by *Shim*, is not the same as, and does not teach or suggest, “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification,” as recited in claim 1. Such disclosure also does not teach or suggest the “guidance” recitations of claims 36, 59, and 67. Accordingly, neither *Maloney* nor *Shim*, nor any combination thereof, teaches or suggests the “guidance” feature as recited in claims 1, 36, 59, or 67, which is incorporated in dependent claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69. For at least this reason, *prima facie* obviousness has not been established with respect to dependent claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69.

Moreover, *prima facie* obviousness has not been established with respect to Appellants' claims at least because the requisite motivation to combine *Maloney* and *Shim* is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness

by the Board, must be supported by “substantial evidence”). The desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action provides no “substantial evidence” to support the attempted combination of *Maloney* and *Shim*. For example, the Examiner has not shown, by substantial evidence, that a skilled artisan considering the cited references, and not having the benefit of Appellants’ disclosure, would have been motivated to combine the references in a manner resulting in Appellants’ claimed combination. The Examiner merely provides a description of how *Shim* allegedly teaches certain features without a proper motive for combining *Shim* with *Maloney*.

Specifically, the Examiner alleges that a skilled artisan would combine the references “because recommending a beauty product as a function said zodiac signs of fortune would advantageously stimulate consumers to buy more beauty products” and “would advantageously enhance the effectiveness of advertising.” OA at 14 and 16. However, these conclusory allegations are not properly supported by evidence on the record.

M.P.E.P. § 2143 specifies that the requirements for establishing *prima facie* obviousness must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001). As M.P.E.P. § 2142 articulates:

Knowledge of applicant’s disclosure must be put aside....
[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

The conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the cited references, but instead, were improperly reconstructed from the teachings of Appellants' application. Hence, the conclusions in the Office Action constitute improper hindsight reasoning.

Because the required motivation to combine *Maloney* and *Shim* is lacking, and since these references would not teach or suggest each and every claimed feature even if combined, *prima facie* obviousness has not been established with respect to these claims.

3. Claims 54, 57, and 58.

- a. *Maloney* and *Shim* do not teach or suggest, separately or in combination, "recommending at least one beauty product to [a] subject as a function of a birth-related classification and at least some of the received profile information" or "providing to a user of [a] second website a recommendation to use a beauty product offered for sale through [a] first website, the recommendation being a function of a birth-related classification of the user."**

Claim 54 depends from base claim 53, and claims 57 and 58 depend from base claim 56. As explained above, *Maloney* does not teach or suggest "recommending at least one beauty product to [a] subject as a function of a birth-related classification and at least some of the received profile information" or "providing to a user of [a] second website a recommendation to use a beauty product offered for sale through [a] first website, the recommendation being a function of a birth-related classification of the user," as recited in independent claims 53 and 56, respectively.

Further, *Shim* does not overcome the deficiencies of *Maloney*. Targeting advertisements from beauty clinics, as mentioned by *Shim*, is not the same as, and does not teach or suggest, this "recommending" or "providing a recommendation"

feature. Hence, neither *Maloney* nor *Shim*, nor any combination thereof, teaches or suggests each and every feature of claims 54, 57, and 58. For at least this reason, *prima facie* obviousness has not been established with respect to these claims.

Moreover, *prima facie* obviousness has also not been established with respect to claims 54, 57, and 58 at least because the requisite motivation to combine *Maloney* and *Shim* is lacking, as discussed above for claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69.

4. Claim 55

- a. **Neither Shim nor Maloney teaches or suggests, separately or in combination, “providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject’s astrological horoscope sign and at least some of the received profile information.”**

Independent claim 55 recites, in part, “providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject’s astrological horoscope sign and at least some of the received profile information.” For at least reasons similar to those noted above in connection with claim 1, *Maloney* does not disclose or suggest this feature of claim 55.

Further, *Shim* fails to cure *Maloney*’s deficiencies. Targeting advertisements from beauty clinics, as mentioned by *Shim*, is not the same as, and does not teach or suggest “providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject’s astrological horoscope sign and at least some of the received profile information,” as recited in claim 55. Hence, neither *Maloney* nor *Shim*, nor any combination thereof, teaches or suggests each and every feature of claim 55. For at least this reason, *prima facie* obviousness has not been established with respect to this claim.

Moreover, *prima facie* obviousness has also not been established with respect to claim 55 at least because the requisite motivation to combine *Maloney* and *Shim* is lacking, as discussed above for claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69.

F. The Rejection Under 35 U.S.C. § 103(a) Over *Maloney* In View Of *Shim*, *Nordbye*, and *Williams* Should Be Reversed

1. Disclosure of *Nordbye*

Nordbye is directed to a device “for designating symbolic data [e.g., zodiac signs] and gemstones associated with . . . designated birth data.” *Nordbye*, col. 1, ll. 62-68; col. 3, ll. 50-60. The device has “an adjustable input in the form of precise birth data, and an output portion” providing information on “gemstones, Biblical data, historical and symbolic data . . . related to . . . time of birth.” *Id.*, abstract.

2. Disclosure of *Williams*

Williams is directed to an article of jewelry bearing zodiac signs. *Williams*, abstract; col. 2, ll. 24-40. The article of jewelry contains a disc divided into equal peripheral sections, each of which has a ornamentation, such as zodiac sign. *Id.*, col. 1, ll. 45-48.

3. Claims 21-23 and 48-50

a. *Maloney*, *Shim*, *Nordbye*, and *Williams* do not teach or suggest, separately or in combination, “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification” or “dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified.”

Claims 21-23 and 48-50 ultimately depend upon base claim 1 or 36. As discussed above for claims 1 and 36, although *Maloney* mentions providing a list of

products to a consumer based on a consumer profile category, the reference does not teach or suggest “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification” or “dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified,” as recited in independent claims 1 and 36, respectively.

Further, as discussed above for claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69, *Shim* fails to cure *Maloney*'s deficiencies. For example, targeting advertisements from beauty clinics, as mentioned by *Shim*, is not the same as, and does not teach or suggest, “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification,” or “dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified.”

Finally, *Nordbye* and *Williams*, separately or in combination with *Maloney* and *Shim*, do no cure the deficiencies of *Maloney* and *Shim*. Although *Nordbye* and *Williams* each discloses devices or jewelry that contain zodiac information, they do not teach or suggest “providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification,” or “dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified.”

Hence, neither *Maloney*, *Shim*, *Nordbye*, nor *Williams*, nor any combination thereof, teaches or suggests each and every feature of claims 21-23 and 48-50. For at least this reason, *prima facie* obviousness has not been established with respect to this claim.

Moreover, *prima facie* obviousness has also not been established with respect to claims 21-23 and 48-50 at least because the requisite motivation to combine *Maloney* and *Shim* is lacking, as discussed above for claims 2, 3, 7, 8, 16, 28, 37-42, 63, 68, and 69. Motivation to combine *Nordbye* and *Williams* with *Maloney* and *Shim* is also lacking because the Examiner's alleged motivation is not supported by evidence and does not establish that a skilled artisan would have modified the art in a manner resulting in the inventions defined in claims 21-23 and 48-50. Specifically, the Examiner alleges that a skilled artisan would combine *Nordbye* and *Williams* with *Maloney* and *Shim* "because it advantageously stimulate . . . consumers to buy . . . beauty products, thereby increas[ing] revenue." OA at 15. However, these conclusory allegations are not properly supported by evidence on the record.

M.P.E.P. § 2143 specifies that the requirements for establishing *prima facie* obviousness must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). The conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the cited references, but instead, were improperly reconstructed from the teachings of Appellants' application. Hence, the conclusions in the Office Action constitute improper hindsight reasoning.

VIII. CONCLUSION

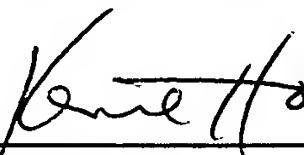
For the reasons given above, pending claims 1-69 are allowable and reversal of the Examiner's rejections is respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 1, 2005

By: 
Kenie Ho
Reg. No. 51,808

IX. CLAIMS APPENDIX

1. (Original) A method of providing guidance for a subject, the method comprising:
 - receiving profile information about the subject, the profile information reflecting at least one of physical attribute information and lifestyle information;
 - receiving information reflecting a classification relating to birth of the subject; and
 - providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the birth-related classification.
2. (Original) The method of claim 1, wherein the birth-related classification is an astrological horoscope sign of the subject.
3. (Original) The method of claim 1, wherein the birth-related classification is at least one of an astrological horoscope sign, a karma classification, a Chinese zodiac sign, an Indian zodiac sign, a Charkas classification, a numerology classification, and a classification based on a way a planetary system was arranged when the subject was born.
4. (Original) The method of claim 1, further comprising using the profile information to categorize the subject in at least one of a plurality of predefined categories, and wherein the guidance is provided as a function of the at least one predefined category and the birth-related classification of the subject.
5. (Original) The method of claim 4, wherein the plurality of predefined categories are organized as subcategories beneath the birth-related classification.

6. (Original) The method of claim 4, wherein the plurality of predefined categories are organized independent of the birth-related classification.

7. (Original) The method of claim 1, wherein the information reflecting a birth-related classification of the subject includes at least one of the subject's birthday and a predefined birth-related classification sign.

8. (Original) The method of claim 5, wherein the predefined birth-related classification sign is an identification of the subject's astrological sign.

9. (Original) The method of claim 1, further comprising prompting the subject to provide profile information, the prompting including posing to the subject a plurality of questions seeking physical attribute information about at least one of the subject's hair, skin, eyes, and facial features.

10. (Original) The method of claim 1, further comprising prompting the subject to provide profile information, the prompting including presenting to the subject a plurality of questions seeking lifestyle information about at least one of the subject's vocation, preferred colors, hobbies, physical fitness, eating habits, cosmetic usage habits, cosmetic preferences, and apparel preferences.

11. (Original) The method of claim 1, conducted over a network, wherein the profile information is received at a server side and the guidance advice is provided to a client side.

12. (Original) The method of claim 1, wherein the guidance includes a recommendation to use a beauty product.

13. (Original) The method of claim 12, further comprising offering the beauty product for sale to the subject.

14. (Original) The method of claim 12, wherein the guidance for the subject and the offer for sale are communicated to the subject over a network.

15. (Original) The method of claim 1, wherein providing guidance to the subject includes providing at least one prediction identified as being based on the birth-related classification.

16. (Original) The method of claim 15, wherein the at least one prediction is identified as being astrologically based.

17. (Original) The method of claim 15, wherein the at least one prediction includes a recommendation to use at least one beauty product.

18. (Original) The method of claim 15, wherein the at least one beauty product bears a brand name pre-identified by the subject.

19. (Original) The method of claim 15, wherein the beauty advice is integrated into the birth-related classification prediction.

20. (Original) The method of claim 15, wherein the beauty advice is presented independent of the birth-related classification prediction.

21. (Original) The method of claim 15, wherein the birth-related classification prediction includes a suggestion that a course of future events may change based on use of certain beauty products.

22. (Original) The method of claim 15, wherein the birth-related classification prediction correlates a use of at least one specified beauty product with a predicted future occurrence.

23. (Original) The method of claim 15, wherein the birth-related classification prediction correlates a failure to use at least one specified beauty product with a predicted future occurrence.

24. (Original) The method of claim 1, wherein the beauty advice includes information on how to apply at least one beauty product.

25. (Original) The method of claim 1, further comprising storing at least some of the received profile information, information reflecting the birth-related classification of the subject, and an address of the subject, and wherein the method further comprises periodically providing guidance to the subject through the subject's stored address.

26. (Original) The method of claim 25, wherein the address is an e-mail address, the method further comprising sending to the subject's e-mail address a birth-related classification prediction, information about a beauty product, and information about how to purchase the beauty product.

27. (Original) The method of claim 26, wherein the information about how to purchase the beauty product includes a hyperlink to a location from which the beauty product may be ordered.

28. (Original) The method of claim 25, wherein the address is an address of a mobile receiver/transmitter of the subject, the method further comprising sending to the subject's mobile address a birth-related classification prediction, information about a beauty product, and information about how to purchase the beauty product via the mobile receiver.

29. (Original) The method of claim 1, further comprising storing an identification code of the subject, so that the user is enabled to receive selective guidance after accessing a website using the identification code.

30. (Original) The method of claim 1, wherein the guidance is further a function of at least one of a demographic location of the subject and an environmental condition at a demographic location of the subject.

31. (Original) The method of claim 1, wherein providing guidance includes providing the subject with at least one prediction associated with the birth-related classification, and thereafter providing beauty advice in response to a request by the subject.

32. (Original) The method of claim 1, further comprising establishing an association between a beauty product supplier and a provider of birth-related classification information, such that when the subject accesses a website of the beauty product supplier, information of the provider is presented to the subject.

33. (Original) The method of claim 1, further comprising establishing an association between a beauty product supplier and a provider of birth-related classification information, such that when the subject accesses a site of the beauty product supplier, a hyperlink to the provider is displayed.

34. (Original) The method of claim 1, further comprising maintaining a plurality of beauty recommendations organized at least in part by birth-related classification, and wherein providing guidance for the subject includes dispensing at least one of the beauty recommendations.

35. (Original) The method of claim 34, wherein the plurality of beauty recommendations are further organized by categories defined by one or more of personal attribute information and personal lifestyle information.

36. (Original) A method for providing guidance to a subject, the method comprising:

establishing a set of criteria for classifying the subject in at least one of a plurality of predefined categories, the criteria including at least one of personal attribute information and lifestyle information;

advising the subject of the at least one predefined categories into which the subject is classified; and

dispensing guidance including beauty advice, the guidance being a function of a birth-related classification of the subject and the at least one predefined category into which the subject is classified.

37. (Original) The method of claim 36, wherein the birth-related classification is an astrological horoscope sign.

38. (Original) The method of claim 36, wherein the birth-related classification is at least one of an astrological horoscope sign, a karma classification, a Chinese zodiac sign, an Indian zodiac sign, a Charkas classification, a numerology classification, and a classification based on a way a planetary system was arranged when the subject was born.

39. (Original) The method of claim 36, wherein the guidance is dispensed through at least one of electronic messaging, website posting, mailing, print media, television media, radio media, and paid advertisements.

40. (Original) The method of claim 39, wherein the guidance is dispensed at a regular interval.

41. (Original) The method of claim 36, wherein the dispensed guidance combines advice based on the birth-related classification with beauty advice.

42. (Original) The method of claim 36, wherein the dispensed guidance combines astrological horoscope advice with beauty advice.

43. (Original) The method of claim 36, wherein the beauty advice includes a recommendation to purchase at least one beauty product.

44. (Original) The method of claim 36, wherein the plurality of predefined categories are organized as subcategories beneath the birth-related classification.

45. (Original) The method of claim 36, wherein the plurality of predefined categories are organized independent of the birth-related classification.

46. (Original) The method of claim 36, wherein personal attribute information characterizes at least one of the subject's hair, skin, eyes, and facial features.

47. (Original) The method of claim 36, wherein the lifestyle information characterizes at least one of the subject's vocation, preferred colors, hobbies, physical fitness, eating habits, cosmetic usage habits, cosmetic preferences, and apparel preferences.

48. (Original) The method of claim 41, wherein the birth-related classification advice includes a suggestion that a course of future events may change based on use of certain beauty products.

49. (Original) The method of claim 41, wherein the birth-related classification advice correlates a use of at least one specified beauty product with a predicted future occurrence.

50. (Original) The method of claim 41, wherein the birth-related classification advice correlates a failure to use at least one specified beauty product with a predicted future occurrence.

51. (Original) The method of claim 36, further comprising maintaining a plurality of beauty recommendations organized at least in part by birth-related classification, and wherein dispensing guidance for the subject includes dispensing at least one of the beauty recommendations.

52. (Original) The method of claim 36, wherein the plurality of beauty recommendations are further organized by categories defined by one or more of personal attribute information and personal lifestyle information.

53. (Original) A method of marketing beauty products, the method comprising:

receiving profile information about a subject, the profile information reflecting at least one of physical attribute information and lifestyle information about the subject; identifying a birth-related classification of the subject; and recommending at least one beauty product to the subject as a function of the birth-related classification of the subject and at least some of the received profile information.

54. (Original) The method of claim 53, wherein the birth-related classification is at least one of an astrological horoscope sign, a karma classification, a Chinese

zodiac sign, an Indian zodiac sign, a Charkas classification, a numerology classification, and a classification based on a way a planetary system was arranged when the subject was born.

55. (Previously Presented) A method of marketing beauty products, the method comprising:

receiving profile information about a subject, the profile information reflecting at least one of physical attribute information and lifestyle information about the subject;

receiving information reflective of an astrological horoscope sign of the subject; and

providing guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject's astrological horoscope sign and at least some of the received profile information.

56. (Original) A method of marketing beauty products, the method comprising:

maintaining a first website offering for sale beauty products;

establishing a relationship between the first website and a second website dispensing birth-related classification information;

providing to a user of the second website a recommendation to use a beauty product offered for sale through the first website, the recommendation being a function of a birth-related classification of the user; and

providing on the second website a link to the first website, and informing the user of the second website of the ability to purchase the beauty product through the link to the first website.

57. (Original) The method of claim 56, wherein the birth-related classification is at least one of an astrological horoscope sign, a karma classification, a Chinese zodiac sign, an Indian zodiac sign, a Charkas classification, a numerology classification, and a classification based on a way a planetary system was arranged when the subject was born.

58. (Original) The method of claim 56, wherein providing a recommendation includes presenting to the user information indicated as being associated with an astrological horoscope and which also contains the recommendation to use a beauty product.

59. (Original) A system of providing guidance for a subject, the system comprising:

a component for receiving profile information about the subject, the profile information reflecting at least one of physical attribute information and lifestyle information;

a component for receiving information reflecting a birth-related classification of the subject; and

a component for providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and the subject's birth-related classification.

60. (Original) The system of claim 59, further comprising a component for using the profile information to categorize the subject in at least one of a plurality of predefined categories, and wherein the guidance is provided as a function of the at least one predefined category and the birth-related classification of the subject.

61. (Original) The system of claim 60, wherein the plurality of predefined categories are organized as subcategories beneath the birth-related classification.

62. (Original) The system of claim 60, wherein the plurality of predefined categories are organized independent of birth-related classification.

63. (Original) The system of claim 59, wherein the information reflecting a birth-related classification includes at least one of the subject's birthday and an identification of the subject's astrological sign.

64. (Original) The system of claim 59, conducted over a network, wherein the profile information is received at a server side and the guidance advice is provided to a client side.

65. (Original) The system of claim 59, wherein the guidance includes a recommendation to use a beauty product.

66. (Original) The system of claim 65, further comprising offering the beauty product for sale to the subject.

67. (Previously Presented) A method of providing guidance for a subject, the method comprising:

receiving profile information about the subject, the profile information reflecting at least one of physical attribute information and lifestyle information;

receiving information reflecting at least one of when and where the subject was born; and

providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and a classification correlating to at least one of when and where the subject was born.

68. (Original) The method of claim 67, wherein the classification is at least one of an astrological horoscope sign, a karma classification, a Chinese zodiac sign, an Indian zodiac sign, a Charkas classification, a numerology classification, and a classification based on a way a planetary system was arranged when the subject was born.

69. (Original) The method of claim 67, wherein the classification is based on an abstraction lacking a relationship to a scientific principle.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.